

# Proposal for URS Policy and Operational Recommendations

## IMPORTANT

- This form is used by RPM Working Group members to submit proposals for URS policy and operational recommendations. Please submit to [ariel.liang@icann.org](mailto:ariel.liang@icann.org).
- **Proposals submitted not using the required form will not be in order and will not be discussed.**
- **One individual form must contain only one proposal for one recommendation.**
- Answer to every text field is required and mandatory(\*).
- As soon as practical after receiving the submissions, staff will forward the proposals to the Working Group email list.
- The final date for submission of member proposals is **COB on Friday, 31 August 2018**. Any proposal received after that date will not be in order and will not be discussed.

## I. General Questions

### \*1. Proponent's Full Name

If this proposal is developed by more than one WG member, please write the full names of all proponents involved

George Kirikos\_\_\_\_\_

### \*2. What type of URS recommendation are you proposing?

Policy

Operational Fix

Other (please specify: \_\_\_\_\_)

### \*3. What URS recommendation are you proposing?

Please be succinct as well as substantially specific and not general in nature. One proposal for one recommendation only.

[NB: Topic can be deferred to Phase 2 of our work, as it applies to both the URS and the UDRP.]

The URS and UDRP policies shall be changed to require that complainants (**excluding prior registrants of the domain name**) prove that a domain name was created in bad faith (with the creation date of the domain name being the relevant date), replacing the current ambiguous registered in bad faith standard. **In the event that a prior registrant of the domain name brings a dispute as complainant, they instead need only prove that a domain name was acquired in bad faith** (with the acquisition date of the domain name by the current registrant being the relevant date). All other remaining prongs of the 3-part test shall continue as before (e.g. use in bad faith, no legitimate interest, confusingly similar to a TM).

[bolded language above reflects revisions from the prior Proposal #12, after discussions with Rebecca Tushnet]

## II. Justification Statement

### **IMPORTANT**

- Must be no more than **250 words** in length for each of two sections below.
- Should state the operational or policy rationale for the proposal.
- Should cite any evidence in support of it. Such evidence may be information developed by the Sub Teams or documented in other sources.

### **\*4. What is your rationale for the proposal? (250 words max)**

Pro-complainant UDRP and URS panels have, due to the ambiguous nature of the term “registered”, long interpreted it to mean the date the current registrant acquired the domain name (see Question 5 below), rather than its creation date. This means that a domain name that was created in good faith can potentially be found to have been “registered in bad faith” if it is assigned to a new registrant, because the date of the test changes. This is a deep policy error in interpretation by panelists, treating domain registrants differently than owners of other intellectual property such as TMs, copyrights or patents.

When the DNS was relatively young in the 1990s or early 2000s, this might have been an innocent mistake. But, domain names themselves are now recognized as valuable intellectual property in themselves (see SEC filings, for example, like <https://www.sec.gov/Archives/edgar/data/1645194/000119312515394008/d30149dex99h4.htm>). It's no longer acceptable to treat domain names as second-class citizens that are somehow inferior in standing to TMs, copyrights and patents. Domain name rights, and in particular their assignment to others, should no longer be penalized for being transferred to others. Such penalties can hamper the sale of assets of a business, succession planning for families, the resolution of estates after a death, and corporate reorganizations, among other deleterious effects.

This proposal will reduce risks and harm to registrants of ownership transfers, thereby protecting registrant rights.

### **\*5. What evidence do you have in support of your proposal? Please detail the source of your evidence. (250 words max)**

WIPO overview 3.0 answer 3.9 discusses the current panel views:

<http://www.wipo.int/amc/en/domains/search/overview3.0/#item39>

“On the other hand, the transfer of a domain name registration from a third party to the respondent is not a renewal and **the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith**. This holds true for single domain name acquisitions as well as for portfolio acquisitions.” (emphasis added)

A (rare) case where a panel correctly recognized that a transfer of ownership of a domain makes the new registrant a successor-in-interest was the Voyuer.com UDRP at: <http://www.adrforum.com/domaindecisions/433802.htm>

(a careful reading of that decision shows the panel found that Respondent was determined to have registered the domain as of the original creation date, as a successor-in-interest, not its acquisition date)

Other intellectual property such as TMs, copyrights, and patents can be fully assigned to new owners without the “penalty” in terms of resetting priority dates that UDRP/URS panels have been handing out to domain registrants. This is evidence in law, where assignees are treated no differently than original registrants for TMs, copyrights and patents. Transfers of ownership do no harm to the new owners by applying a different date/standard to any test for rights/priority.

The now discredited Octogen analysis, which attempted to treat renewal dates as the “registered” date, demonstrates how far pro-complainant panels have gone to harm registrant rights through creative reinterpretation of the policies.

### III. Pertinent Questions

- *The proposal must address the following three questions*
- *Can be no more than 250 words in length for each of two sections below.*

#### **\*6. Where and how has this issue been addressed (or not) by the Working Group or the Sub Teams to date? (250 words max)**

This topic hasn't been addressed by the working group or sub teams prior to October 2018, but had been previously presented as "Proposal #12". When proposal #12 was presented, Rebecca Tushnet noticed an unintended consequence, namely that a prior registrant whose domain name was stolen or was inadvertently allowed to expire and was auctioned by a registrar after expiration but prior to being deleted (and thus whose transfer to future owners was not knowingly done in a manner designed to preserve the domain's creation date as the priority date as a successor-in-interest) might be unable to assert their trademark rights against the new registrant. The revised proposal removes that scenario. By making the tweak, it distinguishes between normal domain transfers that are intended to preserve all rights and attributes inherent in a domain name (including the creation date as the priority date), and unusual/exceptional domain transfers that don't have such intentions (stolen domain names, domains inadvertently allowed to expire that are auctioned by a registrar prior to being deleted).

#### **\*7. Does the data collected and reviewed by the Sub Teams show a need to address this issue and develop recommendations accordingly? (250 words max)**

Sub Teams did not even attempt to survey registrants, who are deleteriously affected by the current incorrect interpretation of "registered" by panels. To the extent that a single practitioner who has represented registrants in the URS was surveyed, there was an imbalance and that person's data was overwhelmed by the 13 that represented complainants, and thus this was an unrepresentative sample that didn't capture the issue. More data can and should be collected during Phase 2 of our work (where we will specifically study the UDRP; the 3-prong tests are the same in both the URS and UDRP).

#### **\*8. If not already addressed above, on the basis of what information, gathered from what source or Sub Team, is this proposal based, if any? Please provide details. (250 words max)**

As noted in section 6, this revised proposal is a revised version of the prior "Proposal #12." I wish to thank Professor Tushnet for sharing her keen insights into the unintended consequences in the original proposal, and her solution has been reflected in this new version.

This proposal also aligns with a court precedent, the California Court Decision in *GOPETS v. Hise*:

<http://cdn.ca9.uscourts.gov/datastore/opinions/2011/09/22/08-56110.pdf>

"The primary question before us is whether the term "registration" applies only to the initial registration of the domain name, or whether it also applies to a re-registration of a currently registered domain name by a new registrant. We hold that such re-registration is not a "registration" within the meaning of § 1125(d)(1)."